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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,284	09/14/2000	Ken Hayward	D990171	9833

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EXAMINER
FADOK, MARK A

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 08/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/662,284	HAYWARD ET AL.	
	Examiner	Art Unit	
	Mark A Fadok	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Amendment

The Examiner is in receipt of Applicant's response to office action mailed March 27, 2002, applicant's response being dated June 21,2002. Acknowledgement is made that the applicant has amended claims 1,4-5,9-10,14,15, and 17 and has added claim 21. The Examiner has carefully reviewed the Applicant's response and has determined that the rejection stands and is resubmitted below addressing the claims as modified by said amendment. Additionally, since applicant has requested abeyance of the provisional double patent rejection until after allowable claims are determined, the double patent rejection also stands and is restated below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of double patenting over the claims and specification of copending Application No.

09/397,126. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Both application deal with replacement of parts on computer peripherals using sensing devices and remote monitoring techniques.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 12 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kageyama (6,333,790).

In response to claim 1, Kageyama discloses a method of ordering a part for a [xerographic] apparatus comprising: monitoring electronically a condition of a replaceable part in a first device (abstract), the replaceable part having: a first condition upon installation; at least one intermediate condition after use; and a third condition when a replacement part is substantially necessary (col 18, lines 55-67);

electronically sending a signal to a second device, the signal automatically electronically offering to purchase identification of at least one of the first condition, condition in the replaceable part ; and sending a digital electronic signature associated with the offering to purchase the replaceable part (col. 2, lines 9-67).

In response to claim 2, Kageyama teaches predicting a condition of the part prior to the electronically sending the signal (**FIG 10, AVERAGE LIFE TIME**).

In response to claim 3, Kageyama teaches receiving electronically an acceptance of the offer to purchase the replaceable part (Claim 4).

In response to claim 4, Kageyama teaches installing the replaceable part prior to occurrence of the third condition. Kageyama teaches monitoring the life cycle of the replaceable parts and ordering and replacing the parts prior to failure/consumption (**FIG 10**). Therefore, Kageyama teaches installing the replaceable part prior to the occurrence of the third condition.

In regards to claim 5, Kaygeyama teaches delivering the replaceable part

to the first device when monitoring indicates the condition of the part is between about the first condition and the third condition (col. 13, lines 7-17).

In response to claim 6, Kageyama teaches providing information relating to the signal to at least one of a user, a supplier, and a third party (col. 10, lines 34-38).

In response to claim 7, Kageyama teaches wherein the information relates to at least one of: (1) a present condition of the part; (2) a prediction of a future condition of the part; (3) an inquiry; and (4) an offer to purchase (Claim 3).

In response to claim 8, Kageyama teaches using a sensor and software system to perform monitoring and predicting of a condition of the part (col 10, lines 16-23).

In response to claim 9, Kageyama teaches wherein at least one of the first device and the second device are interactive (**FIG 16**).

In response to claim 12, Kageyama teaches wherein the information further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; {4) rate of depletion of a consumable; (5) rate of wear of the consumable; (5) predicted date of depletion of the consumable; (5) a predicted date of need of a consumable; (6) delivery schedule of a consumable; and (5) statistical data relating to a part (col 11, lines 21-29).

In response to claim 21, Kageyama teaches wherein the electronically sending of the signal to the second device is a wireless communication. Kageyama does not specify over what medium the signals are being transmitted. However, it is well known in the art that communication links can be established over hardwire or by wireless means. Therefore, it is understood that the connection that forms the link can be one of either hardwire or wireless. It would be obvious to a person of ordinary skill in the art to include in Kageyama, wireless connections, because many printers are still not connected to a server, via a hardwire, with access to a network, thus providing a wireless connection can provide access to the invention of Kageyama without a hardwire.

Claims 10,11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama , and further in view of Brown (5,445,295).

In response to claim 10, Kageyama teaches displaying a purchase order screen including data relating to the part automatically filled out on the purchase order screen based on an identified condition ; and sending the data electronically to a supplier of the part after personal information data is automatically entered by an application program into the purchase order screen. Kageyama teaches displaying a purchase order screen and sending data electronically to a vendor, but does not specifically mention automatically entering personal information using an application program. Brown teaches using the use of computer 76 and form filler 80, to prompt the system to create appropriate forms instructing re-supply vendors 84,86

and 88 when stock is low (Col 7, lines 3-28). It would be obvious to a person of ordinary skill in the art to include in Kageyama, automatically entering applicable personal data such as ship to information into the request for a replacement part, because if this information was not presented to the supplier and was not automatically entered into a request to order the part, a separate communication or action would be required to complete the transaction and have the parts delivered.

In response to claim 11, Kageyama teaches sending data to the supplier after a user enters data (Brown, **FIG 2**).

In response to claim 14, Kageyama discloses a method of ordering a part for an Apparatus comprising: identifying electronically a condition in an apparatus; automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase to a supplier based on the condition; displaying a purchase order screen including a part number for a part automatically filled out on the purchase order screen based on the identified condition; sending an electronic purchase order for the part; and sending a digital electronic signature associated with the purchase order for the part. (see response to claims 1 and 10)

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama (6,333,790) in view of Venkatraman et al. (6,170,007).

In response to claim 15, Kageyama discloses a method of ordering a part for a marking device comprising: sensing a condition at a consumable part in the marking device, the marking device adapted to predict a code indicative of a threshold of a consumable (**FIG 12**); launching an electronic communication to access a computer at an address defined by the condition; sending an electronic purchase offer for a replacement for the consumable part to the electronic address defined by the condition; and sending a digital electronic signature associated with the purchase offer. Kageyama teaches a system for automatically ordering a consumable part over a network, but does not specifically teach returning an electronic address. Venkatraman teaches returning a web page address from the device memory (FIG 1B). It would be obvious to a person of ordinary skill in the art to include in Kageyama the saved information of a web address, because this information would be needed to contact the supplier, and having the information self contained on the device would be convenient.

In response to claim 16, Kageyama teaches wherein the consumable part is functionally associated with a sensor and software system to sense and predict a condition in the device and to electronically communicate information, the sensor and software system including logic adapted to initiate a purchase order defined by the condition (**FIG 8**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13,17,18,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama, and further in view of M2 PRESSWIRE.

In response to claim 17, Kageyama discloses a method of ordering a part for an imaging apparatus comprising: identifying electronically a condition in a consumable part (claim 1), the consumable part including at least one an ink cartridge, toner cartridge, photoreceptor cartridge, paper, and printhead (col 8, lines 1-20), the consumable part having a first condition upon installation, at least one intermediate condition after use, and a third condition when a replacement of the consumable part is substantially necessary (see response to claim 1);

using a software and sensor system associated with the apparatus for at least one of: (a) electronic monitoring of the condition of the consumable part; (b) electronic predicting of the condition of the consumable part; and after at least one of (a) and (b); (c) automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase a replacement for the consumable part at an occurrence or prediction of at least one of the first condition, intermediate condition, and third condition (col 2, lines 9-67);

sending a purchase offer for a replacement for the consumable part to a URL address defined by the identified condition in the consumable part; and sending a digital electronic signature associated with the purchase offer. . Kageyama teaches a communications link over a network conveying information on the condition of the replaceable part, but does not specifically mention launching a link to a manufacturers URL. M2 PRESSWIRE teaches "MarkVision gives "Direct access to the HTML setup pages of print servers from Lexmark, Xerox and Tektronix." (Page 1). It would be obvious to a person of ordinary skill in the art to include in Kaygeyama a link to manufacturers URL's as taught by M2 PRESSWIRE, because in order for a link to be established between the manufacturer and the peripheral device an address would need to be established and one of the quickest way to do this is to use a pre-designated link to the manufacturers URL.

In response to claim 18, Kageyama teaches receiving electronically an acceptance of the offer to purchase (col 3, lines 4-12).

In response to claim 19, Kageyama teaches wherein the communication further relates to at least one of: (1) present supply of a consumable; (2) wear of a consumable; (3) usage of the part; (4) rate of depletion of a consumable; (5) rate of wear of the consumable; (5) predicted date of depletion of the consumable; (5) a predicted date of need of a consumable; (6) delivery schedule of a consumable; and (5) statistical data relating to a part (**FIG 10 and 12**)

In regards to claim 13 and 20, Kaygeyama teaches launching a

communications link to access a URL address, the URL address defined by a condition of the part. Kageyama teaches a communications link over a network conveying information on the condition of the replaceable part, but does not specifically mention launching a link to a manufacturers URL. M2 PRESSWIRE teaches "MarkVision gives "Direct access to the HTML setup pages of print servers from Lexmark, Xerox and Tektronix." (Page 1). It would be obvious to a person of ordinary skill in the art to include in Kageyama a link to manufacturers URL's as taught by M2 PRESSWIRE, because in order for a link to be established between the manufacturer and the peripheral device an address would need to be established and one of the quickest way to do this is to use a pre-designated link to the manufacturers URL.

Response to Arguments

Applicant's arguments filed 6/27/2002 have been fully considered but they are not persuasive.

In regards to Applicants argument with respect to claim 1, that Kageyama does not teach, suggest, or provide motivation for the totality of the combination, the Examiner respectfully disagrees and provides the following rejection based on the amended claim:

Kageyama discloses a method of ordering a part for a [xerographic] apparatus comprising: monitoring electronically a condition of a replaceable part in a first device (abstract), the replaceable part having: a first condition upon installation; at least one intermediate condition after use; and a third condition when a replacement part is substantially necessary (col 18, lines 55-67);

electronically sending a signal to a second device, the signal automatically electronically offering to purchase identification of at least one of the first condition, condition in the replaceable part ; and sending a digital electronic signature associated with the offering to purchase the replaceable part (col. 2, lines 9-67).

In regards to Applicants argument with respect to claim 14, that Kageyama does not teach, suggest, or provide motivation for the totality of the combination, the Examiner respectfully disagrees and provides the following rejection based on the amended claim:

Kageyama discloses a method of ordering a part for an Apparatus comprising: identifying electronically a condition in an apparatus; automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase to a supplier based on the condition; displaying a purchase order screen including a part number for a part automatically filled out on the purchase order screen based on the identified condition; sending an electronic purchase order for the part; and sending a digital electronic signature associated with the purchase order for the part. (see response to claims 1 and 10).

In regards to Applicants argument with respect to claim 15, that Kageyama does not teach, suggest, or provide motivation for the totality of the combination, the Examiner respectfully disagrees and provides the following rejection based on the amended claim: Kageyama discloses a method of ordering a part for a marking device comprising: sensing a condition at a

consumable part in the marking device, the marking device adapted to predict a code indicative of a threshold of a consumable (**FIG 12**); launching an electronic communication to access a computer at an address defined by the condition; sending an electronic purchase offer for a replacement for the consumable part to the electronic address defined by the condition; and sending a digital electronic signature associated with the purchase offer. Kageyama teaches a system for automatically ordering a consumable part over a network, but does not specifically teach returning an electronic address. Venkatraman teaches returning a web page address from the device memory (FIG 1B). It would be obvious to a person of ordinary skill in the art to include in Kageyama the saved information of a web address, because this information would be needed to contact the supplier, and having the information self contained on the device would be convenient.

In regards to Applicants argument with respect to claim 17, that Kageyama and M2 Presswire do not teach, suggest, or provide motivation for the totality of the combination, the Examiner respectfully disagrees and provides the following rejection based on the amended claim: Kageyama discloses a method of ordering a part for an imaging apparatus comprising: identifying electronically a condition in a consumable part (claim 1), the consumable part including at least one an ink cartridge, toner cartridge, photoreceptor cartridge, paper, and printhead (col 8, lines 1-20), the consumable part having a first condition upon installation, at least one intermediate

condition after use, and a third condition when a replacement of the consumable part is substantially necessary (see response to claim 1);

using a software and sensor system associated with the apparatus for at least one of: (a) electronic monitoring of the condition of the consumable part; (b) electronic predicting of the condition of the consumable part; and after at least one of (a) and (b); (c) automatically launching an electronic communications to initiate at least one of an inquiry and an offer to purchase a replacement for the consumable part at an occurrence or prediction of at least one of the first condition, intermediate condition, and third condition (col 2, lines 9-67);

sending a purchase offer for a replacement for the consumable part to a URL address defined by the identified condition in the consumable part; and sending a digital electronic signature associated with the purchase offer. . Kageyama teaches a communications link over a network conveying information on the condition of the replaceable part, but does not specifically mention launching a link to a manufacturers URL. M2 PRESSWIRE teaches "MarkVision gives "Direct access to the HTML setup pages of print servers from Lexmark, Xerox and Tektronix." (Page 1). It would be obvious to a person of ordinary skill in the art to include in Kaygeyama a link to manufacturers URL's as taught by M2 PRESSWIRE, because in order for a link to be established between the manufacturer and the peripheral device an address would need to be established and one of the quickest way to do this is to use a pre-designated link to the manufacturers URL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Fadok whose telephone number is (703) 605-4252. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

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or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok

Patent Examiner

JEFFREY A. SMITH
PRIMARY EXAMINER